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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP  
1300 I STREET, NW  
WASHINGTON, DC 20005

EXAMINER

KIM, AHSHIK

ART UNIT PAPER NUMBER

2876

DATE MAILED: 07/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/651,323

Applicant(s)

AVANT ET AL.

Examiner

Ahshik Kim

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04/09/03 (RCE).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 15.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in  
5 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is  
eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)  
has been timely paid, the finality of the previous Office action has been withdrawn pursuant to  
37 CFR 1.114. Applicant's submission filed on April 9, 2003 has been entered (Paper #13).

### *Preliminary Amendment*

2. Receipt is acknowledged of the preliminary amendment filed on April 9, 2003, which has  
been entered (Paper #14). In the preliminary amendment, claims 1, 18, 35, and 36 were  
amended. Currently, claims 1-36 remain for examination.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the  
basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on  
20 sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 7, 10-12, 14, 17, 18, 24, 27-29, 31, and 34-36 are rejected under 35  
U.S.C. 102(b) as being anticipated Borgendale et al. (US 5,734,568).

Re claims 1, 7, 10, 17, 18, and 34-36, Borgendale teaches a system and the method for  
25 processing and sorting a plurality of mailpiece comprising following steps: marking an

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individual mailpieces with unique identification marking 24, and creating an identification file (called electronic folder) corresponding to the identification number (col. 1, lines 20-49). The system allows accesses to the identification file from various locations (or nodes) such as sending postal location, destination location, and the remote processing system 14 which are  
5 connected via network (see figure 1, col. 3, lines 38+). Although the marking 24 is printed on the front side, as some other references indicate, such identification markings also can be printed on the back side of the mail (See US 5,009,321 to Keough, cited by the Applicant). In the Examiner's opinion, printing the indicia on front or back is not patentably distinct.

Re claims 7 and 24, an assigned serial number for each mailpiece can be considered as a  
10 mailpiece sequence code.

Re claims 10 and 27, as shown in figure 2, the electronic folder contains a serial number 24.

Re claims 11, 14, 28, and 31, the component parts of the electronic folder such as a mail serial no 24, city/state/zip 42, address/street no 422, in broader interpretation, can be considered  
15 as a postal code.

Re claims 12 and 29, the identification file 16 further contains an address block image 45, OCR programs 52, and operating system 54, and the operating system, although not explicitly suggested, contains a system clock, keeping track of when the file is created, or image is captured.

20

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

5 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the  
10 claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)  
15 and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 2-5, 8, 13, 19-22, 25, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borgendale et al. (US 5,734,568) in view of Ulvr et al. (US 5,602,382). The teachings of Borgendale have been discussed above.

Although Borgendale utilizes a mail piece identifier 24 in the form of a barcode,  
20 Borgendale fails to specifically teach or fairly suggest providing detailed description of the identification code, and its component parts.

Ulvr teaches a mail piece sorting/processing system utilizing a barcode identifying each mail piece. Ulvr further discloses component parts of the code such as start code, class code (or Postal code) and stop code (col. 1, line 66 – col. 2, line 8). The bar code further includes  
25 customer information (col. 1, lines 56 – 64) which can include customer address, a date (col. 9, lines 13+) as shown in figure 4b and machine ID (see abstract). Ulvr also uses parity bits (see

figure 3 and 4a) and checksum method to ensure that the code is not in error condition. These status bits indicate an aspect of the identification mark as recited in claims 13 and 30.

In view of Ulvr's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to employ well-known Postal code containing various  
5 information to the teachings of Borgendale in order to efficiently process each mail piece. For example, there may be an occasion to sort the mail by origin, class or time they were processed etc. etc. Furthermore, storage area (i.e., disk space, tapes, etc.) is relatively inexpensive, and the users can add more information to the code without incurring much cost. Thus, adding more fields for further processing as taught by Ulvr would have been an obvious extension to improve  
10 overall productivity of the system.

5. Claims 6 and 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Borgendale et al. (US 5,734,568) in view of Berson et al. (US 6039257). The teachings of Borgendale have been discussed above.

Borgendale fails to specifically teach or fairly suggest that the barcode includes time data.

15 Berson teaches a mail piece sorting/processing system utilizing a barcode identifying each mail piece. The barcode contains identification data and also time-stamp data (col. 2, lines 30+).

In view of Berson's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to further incorporate well-known time data to the teachings of  
20 Borgendale in order to accurately capture the time the mail piece was processed. Adding time data in addition to date would have been an obvious extension, well within the ordinary skill in the art. Furthermore, when modified address have to be applied to the transmitted file in order to

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correct the wrong addresses, it is critical to compare exact the time of transmittal and the time modified ed address file was created, and thus an obvious expedient.

6. Claims 9 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borgendale et al. (US 5,734,568) in view of in view of Ulvr et al. (US 5,602,382) and Berson et al. (US 6,039,257). The teachings of Borgendale as modified by Ulvr have been discussed in paragraph 1, and Borgendale as modified by Berson have been discussed in paragraph 2 above. Accordingly, Borgendale as modified by Ulvr and Berson would have all data elements listed in the claims.

7. Claims 15, 16, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borgendale et al. (US 5,734,568) in view of Allum et al. (US 5,420,403). The teachings of Borgendale have been discussed above.

Borgendale fails to specifically teach or fairly suggest that the postal code in the file is a POSTNET code.

Allum teaches a mail piece sorting/processing system utilizing a POSTNET code identifying each mail piece (col. 3, lines 53+).

In view of Allum's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to employ notoriously old and well-known POSTNET code to the teachings of Borgendale in order to process each mail piece quickly and improve overall throughput of the system. Although conventional barcode or POSTNET code serves the purpose of identifying a mail piece, a POSTNET or modified POSTNET code improves speed of reading/printing such code, and thus an obvious expedient.

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**Conclusion**

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Pollard (US 5,745,590); Pollard et al. (US 6,496,810); Yeung (US 5,712,787) disclose mail processing system and related methods.

- 5 II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203 . The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.


10 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.

15 Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

20 *All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

25

  
Ahshik Kim  
Patent Examiner  
Art Unit 2876  
30 June 16, 2003



DIANE I. LEE  
PRIMARY EXAMINER